

Remarks:

Claims 16-32 are pending.

Claims 1-15 are cancelled, without prejudice or disclaimer.

Claims 16-23 and 26-32 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,558,792 (Vaabengaard) further in view of EP479311 (Minoru). Claims 24 and 25 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Vaabengaard further in view of Minoru, as above, further in view of US 4231369 (Sorenson). Claims 33 and 34 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Vaabengaard further in view of Minoru, as above, further in view of U.S. Patent No. 5,109,874 (Bellingham). Reconsideration of the aforesaid rejections under §103(a) (collectively "the rejections") is requested.

The rejections indispensably rely on combining the teachings of Vaabengaard and Minoru in the same manner, in order to show *prima facie* obviousness, the initial and continuing burdens of which rest with the PTO. *In re Oetiker*, 24 USPQ 1443, 1444 and 1447 (Fed. Cir. 1992). Since the combination of teachings common to the rejections constitutes clear error (as explained below), none of the rejections can be maintained. See *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988).

First of all, applicants repeat, and incorporate herein by reference, their traverse of the rejections set forth in their response filed February 22, 2011. Secondly, for the reasons detailed below, clear error is shown in all rejections because they indispensably rely on Minoru, which teaches away from the presently claimed invention. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be...led in a direction divergent from

the path that was taken by the applicant," *In re Gurley*, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994), and "an applicant may rebut a prima facie case of obviousness by showing that the prior art teaches away from the claimed invention in any material respect." *In re Peterson*, 315 F.3d 1325, 1331, (Fed. Cir. 2003).

The rejections all allege that styrene-isoprene-styrene polymer (SIS) and styrene-isobutylene-styrene polymer (SIBS) are known, interchangeable equivalents in the art of adhesive compositions, because SIS and SIBS (allegedly) have the same characteristics and "good" properties. According to final action (page 5), the final rejection argues "Minoru...teaches that styrene-isobutylene block copolymers [SIBS] have better tackiness and adhesion than styrene block copolymers containing conjugated dienes such as styrene-isoprene block copolymer and styrene-butadiene block copolymers" and, then, concludes "It would have been obvious....to use the styrene-isobutylene-styrene copolymer of Minoru et al. as the block copolymer of Vaabengaard et al. in order to improve tackiness and adhesion of the adhesive composition of Vaabengaard et al." With all due respect, the argument and conclusion are poorly taken.

First of all, Minoru unequivocally focuses on ways to obtain better tackiness and adhesion. On the other hand, the advantages regarding the presently claimed invention do not relate to tackiness and the adhesion. See the instant specification, page 4, lines 8-18, page 6, lines 1-15, page 8, line 13 – page 9, line 2, and the conclusions after Table 3 (page 19) and Table 4 (page 20).

Minoru describes an adhesive comprising a multiblock polymer, which can be SIS or SIBS. The reference neither teaches nor suggests an adhesive that contains polyisobutylene (PIB). The

choice of either SIS or SIBS for use in the adhesive is, therefore, without any consideration as to the inclusion of PIB, as taught by Minoru. Accordingly, Minoru provides not even a hint to include PIB in an adhesive with SIBS, or with SIS.

Minoru describes a tackifier containing a block copolymer, a tackifier resin, and a softener. The advantages of the Minoru tackifier are explained on page 2, lines 20-24 of EP 0479311A2, i.e.:

The present inventors have made assiduous studies to solve such problems associated with the prior art, and have consequently found that a tackifier composition having stability to heat and ultraviolet rays and excellent tackiness is obtained by blending a block copolymer of an aromatic vinyl compound and isobutylene having a specific structure, a specific composition and a specific average molecular weight with a tackifier resin and a softener. This finding has led to the completion of this invention.

Moreover, on page 4, lines 1-4, EP 0479311A2 states:

Thus, in accordance with this invention, there can be obtained a tackifier composition having excellent stability to heat or ultraviolet rays compared with a conventional rubber tackifier based on a conjugated diene rubber, and having well-balanced tackiness compared with a tackifier based on a butyl rubber or a tackifier based on a hydrogenated product of a block copolymer composed of styrene and butadiene.

Accordingly, Minoru focuses on advantages in connection with tackifiers, i.e., tackiness.

Looking at the experimental part of Minoru, only examples 4-6 compare the use of SIBS with the use of SBS in the tackifier. Other examples compare SIBS with either natural rubber or butyl rubber, neither of which is related to the presently claimed invention. Examples 1-3 of Minoru explain test results with respect to tackiness, adhesion, and retention.

At page 6, lines 3-4, Minoru states (emphasis added): "From the data shown in Table 3, it becomes apparent that the tackifier composition of this invention is inferior in retention but by far superior in tackiness and adhesion, to the tackifier composition based on the hydrogenated product

of the styrene-butadiene-styrene block copolymer." Again, the teaching of Minoru is focusing on tackiness and adhesion.

However, the rejection conclusion (above) also mentions that the tackifier according to Minoru is inferior in retention. The retention test is related to the cohesiveness of the tackifier/adhesive composition. Thus, the Minoru adhesive is not taught to be superior in cohesiveness. On the other hand, as taught in the instant specification (page 8, line 15), advantages obtained in accordance with the presently claimed invention concern increased cohesiveness.

Thus, the skilled person would never use the teachings of Minoru to reach the presently claimed adhesive, because Minoru teaches away from the goals and advantages of the invention presently claimed. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be...led in a direction divergent from the path that was taken by the applicant." *Gurley*, 31 USPQ2d at 1131. Applicants, therefore, "rebut...[any alleged] prima facie case of obviousness by showing that the prior art teaches away from the claimed invention in any material respect." *Peterson*, 315 F.3d at 1331.

In view of the foregoing remarks, the rejections are overcome. Withdrawal of the rejections is in order.

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Favorable action is requested.

Respectfully submitted,

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